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TOTAL NUMBER OF PAGES: 11  
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MESSAGE:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Richard H. BOIVIE  
Serial No.: 09/696,566  
For: **MULTICAST ENABLED MAIL**  
Docket No.: YOR920000591US1 (160-A00-011)

Per our telephone conversation with you earlier today, and in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated November 27, 2006, enclosed please find the following documents for *re-submission* due to an unintentional formatting error (that was originally submitted to the Patent Office on November 20, 2006). We thank you for accepting this re-submission of the Pre-Appeal Brief Request for Review and for reconsideration of our remarks/arguments:

1. Pre-Appeal Brief Request for Review  
(5 pages – **replacement document**);
2. A **copy** of the Pre-Appeal Brief Request for Review  
(1 page – originally submitted November 20, 2006);
3. A **copy** of the Notice of Appeal  
(2 pages – originally submitted November 20, 2006); and
4. A **copy** of the Notice of Panel Decision from Pre-Appeal  
Brief Review dated November 27, 2006 (2 pages).

DEC 12 2006

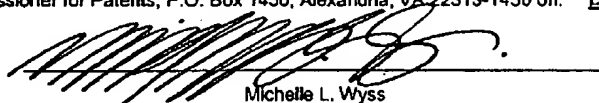
## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.:	09/696,566	Confirmation No.:	2909
Appellant:	Richard H. Boivie	Customer No.:	23334
Filed:	October 25, 2000	TC/A.U.:	2155
For:	MULTICAST ENABLED MAIL	Examiner:	Philip B. Tran

Docket No.: YOR920000591US1 (160-A00-011)

CERTIFICATE OF FACSIMILE TRANSMISSION

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Michelle L. WyssPRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are submitted to be considered along with the Appellant's notice of appeal. The combination of references cited by the Examiner does not describe, teach, nor suggest the presently claimed invention.

Haggerty, Hardjono, and Francis Do Not Teach the Presently Claimed Invention

The following remarks and arguments are with respect to independent Claims 1, 3, 6 and independent Claim 8, 13, and 17, where similar claim language exists. The Appellant traverses the Examiner's assertion that Haggerty teaches the claimed element of:

"receiving a mail message that is created and sent by a user, the user associating the mail message with a plurality of individual destinations"

The Appellant respectfully suggests that the Examiner is confusing ordinary multicast as taught by Haggerty with the method of the presently claimed invention. Haggerty only teaches standard multicast. For example, Haggerty explicitly teaches using a Class D IP address, which is used for standard multicasting. See Haggerty at col. 13, lines 10-35. In standard multicast, which is receiver oriented because the receivers, and not the sender, associate themselves with a multicast group address, a multicast packet is sent to a single multicast group address. The sender, for example, has no way of selecting which receiver will or will not receive the multicast message. The message is sent to all recipients or to none. Haggerty explicitly states "to send an IP multicast datagram (packet), the sender specifies the IP multicast group address". See Haggerty at col. 3, lines 66-67.

The final destinations are not specified by the sender, only the multicast group address is specified by sender. Also, please note that the sender in traditional multicast, such as taught in Haggerty, is not a user. The sender is a multicast server device in the network. Also, using traditional multicast, as taught by Haggerty, is inappropriate for distributing mail since in traditional multicast the sender (e.g., a multicast server device) does not associate any particular destinations with a message. According to an embodiment of the presently claimed invention, on the other hand, the sender (i.e., including the user) specifically associates the destinations, by their destination addresses, with the mail message created by the sender. This is different than Haggerty.

Also, throughout the various Office Actions the Examiner states that Haggerty teaches "receiving multicast packet with destinations IP addresses of a multicast group", see page 8, 3<sup>rd</sup> paragraph of the current Office Action. However, not even at the citations given by the Examiner does Haggerty teach a multicast packet including a plurality of destinations. This is because Haggerty teaches a **standard multicast packet** (i.e. a single multicast group address). Therefore, with respect to Claims 1, 3, and 6 Haggerty does not teach, anticipate or suggest "receiving a mail message that is created and sent by a user, the user associating the mail message with a plurality of individual destinations" as recited by the present invention. Further differences between the presently claimed invention and Haggerty with respect to standard multicasting and the multicasting of the presently claimed invention can be found on pages 9-11 of the Response With Amendment Filed May 5, 2005.

The Appellant also traverses the Examiner's assertion that Haggerty teaches the claim element:

"sending a single copy of the mail message, in a multicast packet and using a reliable multicast technique, across the network via at least one intermediate node to the plurality of individual destinations, the plurality of individual destinations corresponding to a plurality of individual destination network addresses"

The Examiner cites col. 6, lines 12-22; col. 13, lines 36-45; and col. 17, lines 30-64 of Haggerty in support thereof. The Appellant respectfully points out that a **single multicast group address** as taught by Haggerty is **NOT** the same as a plurality of individual destinations that correspond to a plurality of individual destination network addresses. In standard multicast, as taught by Haggerty, receivers subscribe and associate themselves with a multicast group address. The Appellant respectfully suggest that the Examiner is confounding a single multicast group address to be the same as a plurality of individual destinations that correspond to a plurality of individual destination network addresses.

The multicast packet in Haggerty includes a single multicast group address that allows the multicast packet to be transmitted to the multicast group. The single multicast group address is not used for sending the multicast packet to local host subscribers. The MCast router uses its own information (i.e. its knowledge of each of its subscribers) to forward a copy of the packet onto its local subnet. Also, as described

above, Haggerty is completely inappropriate for distributing mail since in a mail system the sender/user specifies the receivers while in traditional multicast, such as in Haggerty, the receivers are the ones that individually subscribe to receive a multicast message and the sender (e.g., the multicast server) does not control (does not affirmatively associate the message with) who will be the specific individual receivers in the plurality of recipients of the multicast message.

The Examiner is incorrect with his assertion that Haggerty teaches a multicast packet including "a plurality of individual destinations..., the plurality of individual destinations corresponding to a plurality of individual destination network address". A destination network address is the actual physical address of the device that is to receive the mail message. As stated above, Haggerty only teaches that the multicast packet contains a **single multicast group address**. Haggerty does not teach or suggest that the physical addresses of the plurality of destinations are included within the multicast packet.

The Examiner correctly states on page 9 of the present Office Action that Haggerty does not teach "distributing electronic mail message across the network using multicast technique". However, the Examiner goes on further to state that Hardjono discloses that multicasting is well-known in the art for transmitting data messages such as email messages to selected groups of users across a network like the Internet and relied upon the Abstract and col. 1, lines 13-25 of Hardjono in support thereof. Hardjono merely mentions in the background section "[o]ne simple example of multicasting entails transmitting an Email message to a plurality of users that each are on a mailing list." See Hardjono at col. 1, lines 15-17. Hardjono never again mentions an email message nor how to use multicast with an email message. Therefore, Hardjono is not enabling with respect to using multicast with an email message. Additionally, at the time of the present invention, one of ordinary skill in the art would be familiar with using unicast for transmitting email and not multicast. Multicasting email messages was not well known in the art as asserted by the Examiner. "All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim". See MPEP § 2116.01. "To support a rejection under 35 U.S.C. 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, Appellant's claimed invention would have been obvious." See Id. "Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained" See Id.

Furthermore, Appellant points out that destinations and destination network address are different. Appellant repeats the arguments made in the previous response to further this point. The multicast packet, as claimed for Claims 1, 3, and 6, includes a packet header comprising a plurality of destination network addresses. As discussed above, the presence of the destination network addresses in the packet header allows the multicast packet to be routed through the network to the final recipient. User-level addresses such as johndoe@abc.com are not kept in the packet header, namely, they are neither physical network addresses, nor are they used to route the multicast packet through the network. Hardjono, like Haggerty, teaches traditional multicast and therefore the Appellant respectfully suggests the Examiner is incorrect when stating that

"multicasting technique is well-known in the art for transmitting data messages such as email messages..." As discussed above, traditional multicast is not appropriate for the distribution of electronic mail because in traditional multicast it is the receivers individually who subscribe and determine they will be receivers in the multicast group. The sender, in traditional multicast being the multicast server and not a user, does **not** determine the receivers of a multicast packet. The sender, on the other hand, in the presently claimed invention does affirmatively determine and associate with the multicast packet who are the recipients of the electronic mail message.

Neither Hardjono, nor the Examiner has pointed out, how a sender in Hardjono can send electronic mail to receivers of his/her choice with traditional multicast. Contrary to Hardjono's assertion, conventional multicast is not used to transmit an electronic mail message to a plurality of users and traditional multicast does not usually include provision for reliable transmissions, as has been claimed for the present invention. Using multicast for email messages is not well known in the art, but is in fact well known **not** to be used to transmit email messages.

Also, the Examiner stated in the various Office Actions that "Haggerty does suggest the user of multicasting technique with unicast packets [see Haggerty, Line 51 to Col. 4, Line 31]". However, if one were to carefully read these citations one would see that Haggerty teaches standard multicast, which does not include unicast addresses. For example Haggerty explicitly teaches the use of Class D address, which are not unicast addresses. Further more, at col. 13, lines 10-11, Haggerty explicitly states "as previously described, a multicast IP packet does not contain an IP destination host address, but rather contains a destination IP address of a multicast group." The Appellant respectfully suggests that the Examiner is confounding that Haggerty teaches using unicast address with multicast packets.

The Appellant also traverses the Examiner's assertion that Francis teaches:

wherein the multicast packet includes a packet header comprising the plurality of individual destination network addresses, wherein at least one of the plurality of individual destination network addresses is a unicast address, and wherein the mail message is destined for reception at the individual destination corresponding to the unicast address as an ordinary unicast packet.

The Examiner combines Haggerty with Francis to overcome Haggerty's deficiency of not teaching the above claim element. However, Francis does not teach this claim element either. Francis, like Haggerty is concerned with standard multicasting. Just because Francis mentions unicast and multicast does not automatically suggest that Francis teaches the above claim element. The Examiner directs the Appellant to col. 5, line 40 to col. 6, line 54; col. 7, line 38 to col. 8, line 33 col. 11, lines 27-48. Col. 5, line 40 to col. 6, line 24 merely describes the use of unicast packets to build a multicast distribution tree. There is no discussion of multicast packets in this citation let alone "a packet header comprising the plurality of individual destination network addresses, wherein at least one of the plurality of individual

destination network addresses is a unicast address, and wherein the mail message is destined for reception at the individual destination corresponding to the unicast address as an ordinary unicast packet". Col. 6, lines 35-54 also does not teach the above claim element. In fact, the packet described at this citation only has a single destination address that corresponds to a multicast group. Col. 7, line 38 to col. 8, line 33 merely describes a mechanism for building a multicast distribution tree. This citation does not teach the above claim element as well. Col. 11, lines 27-48 merely teaches that a node not in a multicast group can forward a received multicast packet. The node retrieves information from a unicast forwarding table being kept at the node itself and lookups up the multicast address of the core node. This is not the same as the above claim element.

The Haggerty reference taken alone and/or in view of Hadjono and/or in view of Francis and/or in view of Shur, and/or in view of Provino does not suggest, teach or disclose the patentably distinct claim elements of "receiving a mail message that is created and sent by a user, the user associating the mail message with a plurality of individual destinations; and sending a single copy of the mail message, in a multicast packet and using a reliable multicast technique, across the network via at least one intermediate node to the plurality of individual destinations, the plurality of individual destinations corresponding to a plurality of individual destination network addresses, wherein the multicast packet includes a packet header comprising the plurality of individual destination network addresses, wherein at least one of the plurality of individual destination network addresses is a unicast address, and wherein the mail message is destined for reception at the individual destination corresponding to the unicast address as an ordinary unicast packet."

In view of the foregoing, independent claims 1, 3, 6, 8, 13, and 17 distinguish over Haggerty, Hardjono, Francis, Shur, and Provino because these references alone and/or in combination with each other do not teach, anticipate, or suggest the presently claimed invention. Also, because Francis does not teach the presently claimed invention, the Examiner's obviousness-type double patenting rejection fails and should be withdrawn. All the remaining claims i.e. 2, 4-5, 7, 9-12, 14-16, and 18-20 depend respectively from independent claims 1, 3, 6, 8, 13, and 17. Accordingly, the claims 1-20 of the present invention distinguish over Haggerty alone and/or in view of Hadjono and/or in view of Francis and/or in view of Shur and/or in view of Provino for the reasons shown above. The Appellant respectfully requests that the Claims 1-20 of the present invention be allowed or in the alternative reopen prosecution on the merits citing art teaching the presently claimed invention.

Respectfully submitted,

Date: December 12, 2006

By: 

Jose Gutman, Reg. No. 35,171  
Attorney for Appellant

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) YOR920000591US1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 20, 2006</u> Signature <u>Mariah Moorehead</u> Typed or printed name <u>MARIAH MOOREHEAD</u>		Application Number 09/696-566	Filed 10/25/2006
		First Named Inventor Richard H. BOIVIE	
		Art Unit 2155	Examiner Philip B. Tran
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature JOSE GULTMAN Typed or printed name	
<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)		Telephone number 561-989-9811	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,171</u>		Date 11/20/2006	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,566	10/25/2000	Richard H. Boivie	YOR920000591US1	2909
23334	7590	11/27/2006		
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487				
			EXAMINER TRAN, PHILIP B	
			ART UNIT 2155	PAPER NUMBER


DATE MAILED: 11/27/2006

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Application Number</b> 	<b>Application/Control No.</b> 09/696,566 Philip Tran	<b>Applicant(s)/Patent under Reexamination</b> BOIVIE, RICHARD H. <b>Art Unit</b> 2155
<b>Document Code - AP-PRE-DEF</b>		

## Notice of Panel Decision from Pre-Appeal Brief Review



COPY

This is in response to the Pre-Appeal Brief Request for Review filed 11-20-06.

1. ☒ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☒ Other: The Request fails to comply with the submission requirements, with state that arguments submitted must be five (5) or less total pages. See 1296 OG 67, 68 (July 12, 2005).

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☐ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Heather R. Herndon

(2) \_\_\_\_\_

*Heather Herndon*  
 Heather R. Herndon  
 Supervisory Patent Examiner  
 Technology Center 2100

(3) \_\_\_\_\_

(4) \_\_\_\_\_